

acknowledges that the Financial Foundations Course and Financial Accounting for Operations products were implemented as part of engagements with General Electric Corp., and that the Business Decision Making product was implemented as part of an engagement with Pratt & Whitney Corp. (*See* Ex. A of the protest, Affidavit of Michael R. Smialek, paragraphs 5, 10 and 14). The Assignee did not deliver the Financial Foundations Course, Financial Accounting for Operations and Business Decision Making products to any other companies.

Applicant did not prepare or deliver documentation to General Electric Corp. and Pratt & Whitney Corp. that describes the detailed operation of the Financial Foundations Course, Financial Accounting for Operations and Business Decision Making products. Applicant reviewed its records in order to find documents to respond to the Requirement for Information and was only able to locate internal undisclosed working documents and documents broadly describing the products at a high level.

However, Applicant was able to obtain copies of the Financial Foundations Course, Financial Accounting for Operations and Business Decision Making products. All three products were designed as stand-alone products and to be used by users without documentation. During the telephone interview of 8/15/01 between Examiner Ingberg and Charles Miller, the Applicant's attorney agreed to bring the products to the Patent Office so that the Examiner could view and examine the actual products. As was discussed during the interview, the Examiner and Applicant's attorney will schedule a personal interview at a later date. The Applicant intends on contacting other Examiners assigned to related cases and demonstrating the products to each Examiner interested in viewing the products. The Applicant believes that after examining the Financial

Foundations Course, Financial Accounting for Operations and Business Decision Making products, the Examiner will agree that the pending claims are patentable.

For example, several references that describe prior goal-based learning and simulation systems developed by the Assignee have already been considered by the Patent Office. In particular, the following references were cited on the Information Disclosure Statements filed June 14, 1999 and July 19, 1999:

Allan Collins; *Goal-Based Scenarios and the Problem of Situated Learning: A Commentary on Andersen Consulting's Design of Goal-Based Scenarios*, Educational Technology, November-December 1994.

Alan Nowakowski, *Reengineering Education at Andersen Consulting*, Educational Technology, November-December 1994.

Joel Montgomery, et al., *Conducting and Supporting a Goal-Based Scenario Learning Environment*, Educational Technology, November-December 1994.

Roger Schank, *Engines for Education*: URL:
http://www.ils.nwu.edu/~e_for_e/nodes/I-M-INTRO-ZOOMER-pg.html.

Furthermore, it appears that Mr. Smialek is not aware of any documents describing the Financial Foundations Course, Financial Accounting for Operations and Business Decision Making products. The protest Mr. Smialek filed includes 12 exhibits containing numerous allegations and none of the exhibits is a prior-art reference or identifies a prior-art patent or printed publication.

The Requirement for Information also seeks the date of first sale and first use of the "products" for which documentation is being submitted. The Financial Foundations Course, Financial Accounting for Operations and Business Decision Making products had long development and deployment cycles and, as a result, it is difficult to determine exactly a date of first use and first sale for each of the products or portions of the products. Furthermore, Applicant was aware of the Financial Foundations Course, Financial Accounting for Operations and Business Decision Making products at the time of drafting the present application and the related applications and respectfully submits that any use or sale of the products does not adversely affect the patentability of the pending claims and claims in the related patents. Accordingly, Applicant has not determined an exact date of first sale or first use for each of the products. However, in order to expedite the prosecution of the present application and related applications, the Examiner may initially assume that a first sale or first use of the products occurred more than 1 year prior to the filing of the present application. Applicant expressly reserves the right to submit evidence to show that any disclosures that are associated with the Financial Foundations Course, Financial Accounting for Operations and Business Decision Making products occurred at a later date.

Response to the Office Action

1. The Office Action indicates that claims 1-19 are allowable. Consequently, the patentability of these claims over the prior art is not discussed herein.
2. The Office Action objected to the declaration because Michael R. Smialek is listed as an author of the computer program claimed and shown in the specification, but is

not named as an inventor. Assignee traverses the objection and respectfully requests reconsideration.

The issue of whether or not Mr. Smialek is an inventor was discussed during the telephone interview of 8/15/01 between Examiner Ingberg and Charles Miller. During the interview, the Examiner expressed his concern that the listing of Mr. Smialek as an author of the computer program suggests that Mr. Smialek aided in the reduction of the invention to practice, which may be relevant to inventorship.

Inventorship is determined by analyzing the facts pertaining to conception of the invention. *See Burroughs Wellcome Co. v. Barr Lab., Inc.*, 32 USPQ2d 1915, 1919 (Fed. Cir. 1994) ("Conception is the touchstone of inventorship"); *see also Sewall v. Walters*, 30 USPQ2d 1356, 1358 (Fed. Cir. 1994) ("Determining 'inventorship' is nothing more than determining who conceived the subject matter at issue"). Here, there is no evidence in the record to suggest that Mr. Smialek contributed to the conception of any claim in the present application or any claim in any of the related patents or applications. As discussed below, after a thorough investigation, Applicant concluded that Mr. Smialek had not contributed to the conception of any of the pending claims and it would be improper to include Mr. Smialek as an inventor.

The issue of whether one who merely reduces an invention to practice is an inventor was addressed by the U.S. Court of Appeals for the Federal Circuit in *Sewall v. Walters*, 30 USPQ2d 1356 (Fed. Cir. 1994). The Court affirmed a decision by the Board of Patent Appeals and Interferences (Board) in which the Board found that "there was no evidence of record indicating that more than ordinary skill would have been needed reduce to practice" the inventor's proposed apparatus. *Sewall* at 1358. The Board found

that the improvement over a previous patent "was fully capable of being implemented by a programmer of ordinary skill in the art by programming a general purpose computer to perform the required mathematical functions or by a hardware designer . . ." and that the alleged inventor who performed these tasks was not an inventor. *Sewall* at 1358. The Court held that the alleged joint inventor failed to persuade the Court that the Board clearly erred in finding that the alleged joint inventor's contribution was merely the exercise of ordinary skill that did not involve any inventive acts. *Sewall* at 1358.

Furthermore, even if Mr. Smialek is the author of the computer code listed on pages 133 through 163 of the present specification, authorship and inventorship are distinct concepts, and the authorship of the program does not in itself make Mr. Smialek an inventor. There is no specific evidence in the record to suggest that that Mr. Smialek contributed to the conception of any subject matter in any claim. Even the Affidavit filed by Mr. Smialek (Ex. A of the protest) fails to provide any specific information indicating that he contributed to the conception of any subject matter in any claim. Because of the absence of any specific evidence suggesting that Mr. Smialek contributed to the conception of any subject matter in any claim, Applicant requests reconsideration of objection to the declaration.

Response to the Protest

Applicant notes that Mr. Smialek made assertions regarding his alleged authorship of various materials given to the attorney responsible for preparation of the instant application. Assuming *arguendo* that such materials were used by the preparing attorney or were even bodily incorporated into the instant application, as indicated above,

Mr. Smialek did not present any specific information indicating that he contributed to the conception of any subject matter in any claim. It is also worthy to note that statements attributed to former and current employees of the Assignee (*see* Ex. A of the protest, Affidavit of Michael R. Smialek, ¶ 20(d), attributing statements regarding Mr. Smialek's status as an inventor to Eric Lannert, and para. 20(e) and 21, attributing statements to William Stoddard) are not supported by affidavits or otherwise from the alleged declarants, and therefore cannot be accorded significance.

Further still, the affidavits of Michael R. Smialek and Michael H. Rubin fail to state that Mr. Smialek started a company, Knowledge Dynamics, shortly after he left the employ of the Assignee. The various exhibits submitted by Mr. Smialek illustrate that he had knowledge of the instant application before and after the filing date (December 22, 1998) thereof (*see* Ex. A of the protest, Affidavit of Michael R. Smialek, ¶¶ 20(e), 22). However, it was not until after counsel for the Assignee approached Mr. Smialek's company, Knowledge Dynamics, (*see* Ex. F of the protest, Letter from L. Keith Stephens to Michael Smialek dated 12/16/99) that this protest was filed. Moreover, the Affidavit of Michael H. Rubin fails to note that Mr. Rubin is currently the Chief Technology Officer for Knowledge Dynamics. Attached hereto is a copy of a web page from Knowledge Dynamic's web site listing Messrs. Smialek and Rubin as part of the management team for that company. (*See* Ex. 1, printout of the web page at <http://www.knowledgedynamics.com/about.html> on July 17, 2001).

In his protest, Mr. Smialek attempts to establish that the failure to name him as an inventor was a "misrepresentation." This misrepresentation is allegedly manifest because

the attorney responsible for drafting the instant application supposedly had knowledge of Mr. Smialek's alleged status as an inventor.

Based on the information currently known, Applicant does not believe that Mr. Smialek was a co-inventor of any claim in the present application or any claim in any of the related applications. And, in the event that Mr. Smialek should have been named as inventor, Applicant submits that the omission of Mr. Smialek as an inventor was not intentional. Indeed, if the Assignee is presented with evidence that Mr. Smialek should be named as an inventor, Applicant will file a petition to correct inventorship in accordance with 37 C.F.R. § 1.48(a). Under Rule 48, such correction can be made if the error in naming the correct inventor was made without "deceptive intent on the part of the person named as an inventor in error or of the person who through error was not named as an inventor."

There is no evidence of deceptive intent in this case. Indeed, there could not have been any deceptive intent. Applicant as well as Mr. Smialek had employment contracts with Assignee. These employment contracts required assignment of any patent rights to Assignee. Since Mr. Smialek was under an obligation to assign his patent rights to the Assignee, it was irrelevant to the Assignee whether Mr. Smialek was named as an inventor. Furthermore, the Assignee contacted Mr. Smialek and offered to take the necessary steps to name Mr. Smialek as an inventor if Mr. Smialek would identify the claims in any of the related patents and patent applications that he believes that he conceived of while an employee of the Assignee. Mr. Smialek has failed to specifically identify any claim that he believes that he conceived of while an employee of the Assignee and has refused to sign any form of agreement or assignment. The

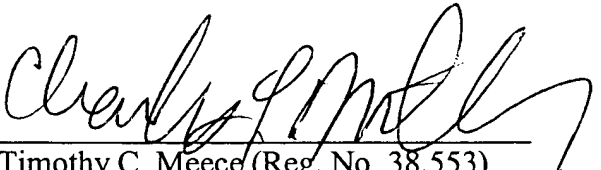
investigation of inventorship that the Assignee was forced to conduct without any cooperation from Mr. Smialek revealed that Mr. Smialek is not an inventor of any of the pending claims or any of the claims in the related patents.

Finally, Mr. Smialek makes broad assertions throughout his protest that the work done as a precursor to the present invention was publicly disclosed or on-sale more than one year prior to the filing date of the instant application. Mr. Smialek has not shown that any pending claim in the present application or any of the related applications reads on any of the alleged public disclosure or on-sale activities. Furthermore, Mr. Smialek has also failed to show why any of alleged disclosure or on-sale activity is any more relevant than the references already considered by the Examiner.

The Examiner is invited to contact the undersigned at the telephone number listed below in the event that the Examiner has any questions regarding Applicant's response.

Respectfully submitted,

BANNER & WITCOFF, LTD.

By: 
Timothy C. Meece (Reg. No. 38,553)
Charles L. Miller (Reg. No. 43,805)

Ten South Wacker Drive
Suite 3000
Chicago, Illinois 60606-7407
(312) 715-1000